

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* TYLER PEPPEL

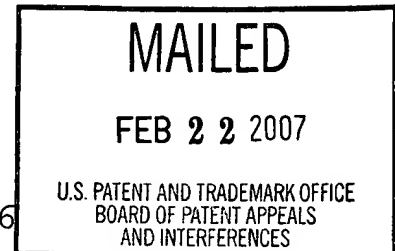
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Appeal No. 2006-3019  
Application No. 09/735,586

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ON BRIEF

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Before BLANKENSHIP, MACDONALD, and LUCAS,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

*DECISION ON APPEAL*

This is a decision on appeal from the final rejection of claims 1-9, 11, 12 and 25-32. Claims 10, 13-24 and 33-37 have been canceled. It is noted that appellant filed an Information Disclosure Statement (IDS) on August 26, 2006. Examiner is reminded to process said submission in accordance with standard procedures.

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*Invention*

Appellant's invention relates to an electronic hardware and software architecture for electronic trading cards described by the appellant as follows:

The invention includes an electronic hardware and software architecture for electronic trading cards (ETCs). The invention has a number of components that function together as a system that support making electronic trading cards, trading electronic trading cards, activities (such as game playing) with electronic trading cards, and collecting electronic trading cards.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A system for the exchange of digital content, comprising:

a disassociated computer code segment embodied in a tangible medium;

said computer code segment expressing said digital content;

said computer code segment further embodied in an electronic format that supports content scarcity and

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content authenticity;

a header identification code that uniquely identifies said computer code segment;

a optional lock and key mechanism to limit access and impose password protection on said computer code segment;

a computer code segment graphic identification code that may include any of an audio visual logo, a copyright notice, and company information;

multimedia data that may include any of animation, video, pictures, sounds, and text;

optional pointers to external data and programs embedded in scripts that trigger the display of external media and/or run external applications;

optional utility programs;

optional applications, including any of incomplete linkable code segments and utilities; and

an optional user writable area for any of personalization, messages, voice recording, and image storage.

### *References*

The references relied on by the Examiner are as follows:

Welsh	US 4,970,666	Nov. 13, 1990
Smith	US 5,533,124	Jul. 2, 1996
	(filed Dec. 7, 1994)	
Cooper	US 5,757,907	May 5, 1998

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*Rejections at Issue*

Claims 1-7, 9 and 25-32 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Smith.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Smith and Cooper.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combination of Smith and Welsh.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.<sup>1</sup>

*OPINION*

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated infra, we affirm the Examiner's rejections of claims 1-9, 11, 12 and 25-32 under 35 U.S.C. § 102(e) and § 103(a).

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<sup>1</sup> Appellant filed an appeal brief on 6/4/2004. Appellant filed a reply brief on 9/15/2004. The Examiner mailed an Examiner's Answer on 8/9/2004.

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Appellant has indicated that for purposes of this appeal the claims stand or fall together. (Brief, Page 11).

**I. Whether the Rejection of Claims under 35 U.S.C. § 102(e) as being anticipated by Smith is proper?**

It is our view, after consideration of the record before us, that the disclosure of Smith fully meets the invention as recited in claims 1-7, 9 and 25-32. Accordingly, we affirm the rejection.

The primary reference cited by the Examiner for establishing the teachings of the prior art at the time of invention was the Smith reference, filed on December 7, 1994 and issued on July 2, 1996. The Appellant does not address Examiner's application of the Smith reference to the claim limitations, but instead asserts that the Smith reference is not available as prior art in this application in view of an Applicant's Declaration pursuant to 37 CFR § 131, which endeavors to establish Applicant's conception of the invention

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prior to December 7, 1994 coupled with due diligence in the reduction to practice continuing to the date of filing of the application.

The current application is a continuation of U.S. application number 08/398,862 filed on March 6, 1995. The '862 application matured into U.S. Patent No. 6,200,216, dated March 13, 2001. In the Office Action of February 3, 2003, the Examiner in the instant application rejected the claims under the judicially created doctrine of non-statutory double patenting. A terminal disclaimer was filed on August 12, 2003.

The Examiner has raised three issues with respect to the Appellant's declaration under § 1.131: First, it is not specific to the application at hand; Second, there is insufficient evidence of conception to support the limitations of the claims; and Third, the declaration does not present sufficient evidence of due diligence over the required period.

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With respect to the first issue, we are concerned with the informal manner in which the Appellant attempts to antedate the Smith reference.

Regulation 37 CFR 1.131(a) reads:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based [emphasis added].

The Examiner has forborne enforcing this regulation, indicating in the Examiner's Answer (Page 6):

Applicant's Declarations (Tab C dated 3/27/97, Tab E dated 9/27/96) pursuant to 37 CFR § 1.131 swear to claims in a different application, 08/398,862. It would be appropriate to file a new Declaration pursuant to 37 CFR § 1.131 specific to the case at hand. Although these are not proper declarations pursuant to 37 CFR § 1.131 with respect to the claims in this application, they are evidence and have been considered for what they show.

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We find this forbearance inappropriate. The declaration under § 1.131 was submitted in a different case, albeit the parent of the instant application, and the record before us provides no such oath or declaration addressed to the instant claims. It is clear from the record that the instant application's rejected claims address somewhat different subject matter than the claimed subject matter in the parent case. Thus a declaration under § 1.131 would be required to address the specifics of conception of the subject matter as claimed in the instant application. This declaration was required prior to the Final Rejection, and certainly before this stage of the appeal process. (See MPEP § 715.09, § 1206).

Without an effective declaration under § 1.131 the Smith reference is not removed, and the rejection under 35 U.S.C. § 102(e) as recited above will be affirmed. However, certain observations with respect to aspects of diligence that have been addressed by the Examiner



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and the Appellant are proffered herewith as guidance.

We have studied in detail the "Declaration of Counsel - Michael A. Glenn" and the "Declaration under 37 CFR § 1.131 - Tyler Peppel" submitted in the file of Application S.N. 08/398,862 (copies of the declarations are attached to Appellant's Brief) and have reviewed the chronology of listed events with respect to the critical period prior to December 7, 1994 to the filing of the parent application on March 6, 1995. We find that certain acts are listed that took place within the critical period, which are substantiated by exhibits. However, the document includes neither a recitation of the span of the activities nor the evidence of continued work that would establish due diligence as required by the case law. The Examiner mentioned two potential lapses: between December 2, 1994 and January 4, 1995, and then from January 4, 1995 to January 22, 1995. We are not unmindful that a holiday season happened to fall in this critical period, but the

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record has to show the required diligence or valid excuses for a lapse. (See *Griffith v. Kanamaru*, 816 F.2d 624, 625-26, 2 USPQ2d 1361, 1362 (Fed. Cir. 1987) which explores diligence in reduction to practice in the context of certain allowable excuses, such as vacations.) We are additionally taking notice of the wording of the Declarations, such as paragraph #7 of the Declaration of Counsel, which seems to express a philosophic point about reasonableness, rather than present a positive averment that, for example, the results of a search were studied over a particular span of time. (E.g. "It is not unreasonable that the inventor would receive the search results some time after his attorney received them, that the inventor would then carefully review these results, and that the inventor would seek competent representation by a patent attorney.") The Appellant has the burden, and the incentive, to clearly state as many details of the conception and due diligence as can be justified by his

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activities with respect to the claimed subject matter.  
(See *In re Borkowski*, 505 F.2d 713, 719, 184 USPQ 29, 33 (CCPA 1974); *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974)).

For the reason set forth above, the rejection of claims 1-7, 9 and 25-32 under 35 U.S.C. § 102(e) is affirmed.

**II. Whether the Rejection of Claim 8 Under 35 U.S.C. § 103(a) as being obvious over the combination of Smith and Cooper is proper? Whether the Rejection of Claims 11 and 12 Under 35 U.S.C. § 103(a) as being obvious over the combination of Smith and Welsh is proper?**

It is our view, after consideration of the record before us and the arguments recited above that claims 8, 11 and 12 are rendered obvious over the cited art. This issue has not been argued by Appellant separately from the arguments over the other claims. Accordingly, we affirm the rejections of these claims.

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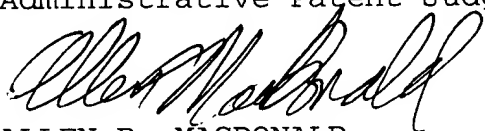
*Conclusion*

In view of the foregoing discussion, we affirm the Examiner's rejections of claims 1-9, 11, 12 and 25-32 under 35 U.S.C. § 102(e) and § 103(a) as indicated above.

*AFFIRMED*



HOWARD B. BLANKENSHIP  
Administrative Patent Judge



ALLEN R. MACDONALD  
Administrative Patent Judge



JAY B. LUCAS  
Administrative Patent Judge

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